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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,598	09/27/2001	Gerhard Wennerstrom	006559.00013	9391

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EXAMINER	
HICKS, CHARLES N	
ART UNIT	**PAPER NUMBER**
2424	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/963,598	WENNERSTROM ET AL.	
	Examiner	Art Unit	
	CHARLES N. HICKS	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-9,11-21,23-26,28,29 and 34-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-9,11-21,23-26,28,29 and 34-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 3-9, 11-21, 23-26, 28-29, 34-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrahan (US 2003/0026424 A1), hereinafter referred to as

McGarrahan, in view of McGowan (US 2003/0018745 A1), hereinafter referred to as McGowan.

5. Regarding claim 1, McGarrahan discloses an apparatus comprising: a receiver configured to receive at approximately the same time primary program data and associated secondary program data from a communication channel **(fig. 2-3, pg. 5, paragraphs 45-48)**;

and a processor configured to: store the primary program data and the associated secondary program data on a data storage medium as separate files **(fig. 5, pg. 8, paragraphs 84-85).**

McGarrahan fails to disclose subsequent to the storage of the primary program data and the associated secondary program data being complete, provide a user interface for selection of the primary program data, and upon the selection, retrieve the associated secondary program data for display. However McGowan discloses subsequent to the storage of the primary program data and the associated secondary program data being complete, provide a user interface for selection of the primary program data, and upon the selection, retrieve the associated secondary program data for display **(fig. 4-5, pg. 5, paragraphs 44-45).** Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

6. Regarding claim 3, McGarrahan discloses the apparatus wherein the secondary program data comprises promotional material selected from the group comprising forms: audio, video, pictures, text and graphics **(fig. 1-2, pg. 5, paragraph 48)**.

7. Regarding claims 4, 12, 19, and 25, McGarrahan discloses the apparatus where the primary program data and secondary program data are in the form of MPEG-2 files **(fig. 1-3, pg 2-3, paragraphs 28-29)**.

8. Regarding claims 5, 13, 20, and 26, McGarrahan discloses the apparatus where the secondary program data is of a lower resolution than that of the primary program data **(fig. 1-3, pg. 3, paragraphs 32-33)**.

9. Regarding claim 6, McGarrahan discloses the apparatus wherein the processor is configured to selectively allow marking of the primary program data for deletion or prolonged keeping upon user input during display of the secondary program data **(fig. 1-3, pg. 5-6, paragraphs 56-57)**.

10. Regarding claims 7 and 14, McGarrahan discloses the apparatus wherein the apparatus comprises a set top box **(fig. 1, pg. 2, paragraph 20-21)**.

11. Regarding claims 8 and 15, McGarrahan discloses the apparatus further including a display device configured to display the primary and secondary data retrieved from the storage medium **(fig. 1, pg. 2, paragraph 20)**.

12. Regarding claim 9, McGarrahan discloses an apparatus comprising: a receiver configured to receive primary program data from a communication channel **(fig. 2-3, pg. 5, paragraphs 45-48)**,

and a data processor configured: record the primary program data on a storage medium **(fig. 5, pg. 8, paragraphs 84-85)**,

run a software agent arranged to identify and copy one or more portions of the primary program data that have been earmarked **(fig. 5, pg. 8, paragraphs 84-85)**,

store a copy of said earmarked data as an associated secondary program data file on the storage medium, wherein the primary program data and the secondary program data are stored in separate files **(fig. 1-3, pg. 3-4, paragraphs 38-39).**

McGarrahan fails to disclose subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored primary program data, and upon the selection, retrieve the associated secondary program data for display. However McGowan discloses subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored primary program data, and upon the selection, retrieve the associated secondary program data for display **(fig. 4-5, pg. 5, paragraphs**

44-45). Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

13. Regarding claims 11 and 23, McGarrahan discloses the apparatus wherein the software agent is configured to replace at least a portion of audio data in the secondary program data with audio data from tertiary program data received by the receiver from the communication channel **(fig. 1-3, pg. 6, paragraphs 62-63)**.

14. Regarding claim 16, McGarrahan discloses a method comprising: receiving at approximately the same time primary program data and associated secondary program data from a communication channel **(fig. 2-3, pg. 5, paragraphs 45-48)**,

and storing said primary program data and the associated secondary program data in separate files **(fig. 5, pg. 8, paragraphs 84-85).**

McGarrahan fails to disclose subsequent to the storage of the primary program data and the associated secondary program data being complete, providing a user interface for selection of the stored primary program data file, and upon the selection, retrieving said secondary program data for display. However McGowan discloses subsequent to the storage of the primary program data and the associated secondary program data being complete, providing a user interface for selection of the stored primary program data file, and upon the selection, retrieving said secondary program

data for display **(fig. 4-5, pg. 5, paragraphs 44-45).** Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

15. Regarding claim 17, McGarrahan discloses the method including receiving the secondary program data in parallel with the primary program data **(fig. 2-3, pg. 5, paragraphs 45-48)**.

16. Regarding claims 18 and 24, McGarrahan discloses the method where the secondary program data comprises promotional material in one or more of the following forms: audio, video, pictures, text or graphics **(fig. 2-3, pg. 5, paragraphs 45-48)**.

17. Regarding claim 21, McGarrahan discloses a method comprising: receiving primary program data from a communication channel **(fig. 2-3, pg. 5, paragraphs 45-48)**,

storing the primary program data on a storage medium **(fig. 5, pg. 8, paragraphs 84-85)**,

running a software application so as to identify and copy one or more earmarked portions of the stored primary program data **(fig. 5, pg. 8, paragraphs 84-85)**,

and storing a copy of the earmarked portions as associated secondary program data file on the storage medium, wherein the primary program data and the secondary program data are stored in separate files **(fig. 1-3, pg. 3-4, paragraphs 38-39)**. McGarrahan fails to disclose subsequent to the storage of the primary program data and the associated secondary program data being complete, providing a user interface for selection of the stored primary program data, and upon the selection retrieving said secondary program data for display. However McGowan discloses subsequent to the storage of the primary program data and the associated secondary program data being complete, providing a user interface for selection of the stored primary program data, and upon the selection retrieving said secondary program data for display **(fig. 4-5, pg. 5, paragraphs 44-45).** Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

18. Regarding claim 28, McGarrahan discloses a computer-readable medium comprising instructions that when executed by a processor causes the processor to: receive at approximately the same time primary program data and associated secondary program data from a communication channel **(fig. 2-3, pg. 5, paragraphs 45-48)**,

store said primary program data and the associated secondary program data as separate files **(fig. 5, pg. 8, paragraphs 84-85)**.

McGarrahan fails to disclose subsequent to the storage of the primary program data and the associated secondary program data being complete, provide a user interface for selection of the stored primary program data, and upon selection, retrieve said secondary program data for display. However McGowan discloses subsequent to the storage of the primary program data and the associated secondary program data being complete, provide a user interface for selection of the stored primary program data, and upon selection, retrieve said secondary program data for display **(fig. 4-5, pg. 5, paragraphs 44-45).** Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

19. Regarding claim 29, McGarrahan discloses a computer-readable medium comprising instructions that when executed by a processor causes the processor to: receive primary program data from a communication channel **(fig. 2-3, pg. 5, paragraphs 45-48)**,

store the primary program data on a storage medium **(fig. 5, pg. 8, paragraphs 84-85)**,

run a software application so as to identify and copy one or more earmarked portions of the stored primary program data, store a copy of the earmarked portions as an associated secondary program data file on the storage medium, wherein the primary

program data and the secondary program data are stored in separate files **(fig. 5, pg. 8, paragraphs 84-85)**,

McGarrahan fails to disclose subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored program data, and upon selection retrieve the secondary program data for display. McGowan discloses subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored program data, and upon selection retrieve the secondary program data for display **(fig. 4-5, pg. 5, paragraphs 44-45).** Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

20. Regarding claims 34, 39, 42, 47, 50, and 52, McGowan discloses the apparatus wherein the processor is further configured to, subsequent to the storage of the primary program data and the associated secondary program data being complete, gather information relating to the associated secondary program data and display the information **(fig. 1-3, pg. 3, paragraph 32)**.

21. Regarding claims 35, 40, 43, 48, 51, and 53, McGowan discloses the apparatus wherein the processor is further configured to display an icon associated with the

primary program data for which the associated secondary program data is available **(fig. 5-7, pg. 5, paragraph 44)**.

22. Regarding claims 36, 41, 44, and 49, McGowan discloses the apparatus wherein the processor is configured to provide the user interface for selection of program titles of the primary program data **fig. 3-7, pg. 4, paragraphs 34-35)**.

23. Regarding claims 37 and 45, McGarrahan discloses the apparatus wherein the associated secondary program data provides one or more trailers for the primary program data **(fig. 1-3, pg. 5-6, paragraph 48)**.

24. Regarding claims 38 and 46, McGowan the apparatus wherein the processor is configured to record the primary program data and the secondary program data according to a user's instructions and to display a list of the recorded secondary program data to the user **(fig. 3-6, pg. 3, paragraphs 31-33)**.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blumenau (US Patent No. 6,505,240 B1) discloses bandwidth requirements for the simultaneous provision of multiple sets of content over a network. Mineyama (US 2003/0121041 A1) discloses a virtual programming list providing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES N. HICKS whose telephone number is (571)270-3010. The examiner can normally be reached on M-F 7:30AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2424

CNH